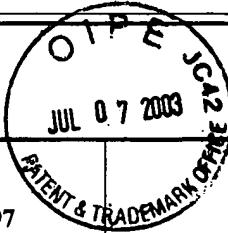


## TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.  
P-3818

In Re Application Of: Michael J. Iskra

Serial No.  
08/928,272Filing Date  
September 12, 1997Examiner  
PatelGroup Art Unit  
3761

Invention: Collection Container Assembly

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TECHNOLOGY CENTER R3700

TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on July 3, 2003

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Signature

Dated:

July 3, 2003

Scott J. Rittman, Esq.  
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201-847-6356

I certify that this document and fee is being deposited on July 3, 2003 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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PATENT  
P-3818

#31  
B. Webb  
7/15/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Michael J. Iskra

SERIAL NO.: 08/928,272

GROUP: 3761

FILING DATE: September 12, 1997

EXAMINER: Patel, Mital B

FOR: COLLECTION CONTAINER ASSEMBLY

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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APPEAL BRIEF

Appellants appeal the final rejection of claims 1 and 5-9 presented in the Office Action dated January 14, 2002. A Notice of Appeal is filed herewith. Please charge the Appeal Brief fee set forth in 37 C.F.R. § 1.17 (c) to Depoist Account No. 02-1666.

37 CFR §1.192(c)(1) -- REAL PARTY IN INTEREST

The real party in interest to this Appeal is Becton, Dickinson and Company, the owner and assignee of the captioned application.

37 CFR §1.192(c)(2) -- RELATED APPEALS AND INTERFERENCES

The Appellant, the Appellant's legal representative, and the assignee are not aware of other related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

### **37 CFR §1.192(c)(3) -- STATUS OF THE CLAIMS**

Claims 1 and 5-9 are pending in the present application, and are presented in the Appendix.

### **37 CFR §1.192(c)(4) -- STATUS OF AMENDMENTS**

There are no outstanding amendments.

### **37 CFR §1.192(c)(5) -- SUMMARY OF INVENTION**

The claimed invention (see Fig. #3) is a one-piece collection container assembly, containing a tubular housing having opposed first and second ends, and a solid partition within the housing between the ends. The solid partition creates a relatively low-volume collection area within the larger tubular housing, such low-volume being desired for some testing applications. The second end has a bottom end below the solid partition, this bottom end comprising a rounded bottom with an open therein.

Due to its rounded open bottom, the one-piece container is universally compatible with clinical diagnostic equipment that is designed for larger, higher volume collection tubes – no adaptors or attachments are required to achieve such compatibility.

### **37 CFR §1.192(c)(6) – ISSUES**

A. Are present claims 1 and 5-9 patentable, under 35 U.S.C. §§ 102(b) and 103(a) over U.S. Patent No. 5,458,854 to Burns (“Burns”)?

### **37 CFR §1.192(c)(7) -- GROUPING OF CLAIMS**

Claims 1 and 5-9 stand or fall together.

### **37 CFR §1.192(c)(8) -- ARGUMENTS**

The Examiner rejected claims 1, 5, 7, and 8 under 35 U.S.C. § 102(b) as being anticipated by Burns and rejected claims 6 and 9 under 35 U.S.C. §103(a) as being unpatentable over Burns.

Claim 1 recites an assembly with the following features (references are to Figs. 3 and 4):

- an elongate tubular housing having opposed first and second ends

- a solid partition 76 positioned within said housing between the first and second ends, the housing defining a volume
- the second end comprising a bottom end 78 below the partition, the bottom end comprising a rounded bottom 80 having an opening 82 therein

(See, e.g., page 8, lines 13-22 of the application)

Burns does not disclose: a bottom end below a solid partition where the bottom end comprises a rounded bottom with an opening therein. In Burns, a cylindrical annular skirt 37 exists below the partition, but this annular skirt does not have a rounded bottom as claimed.

The Examiner takes the position that the partition 38 of Burns (see paragraph 3 of Office Action dated April 8, 2003) constitutes Appellant's claimed rounded bottom. However, Appellant's claim 1 recites (a) a solid partition, and (b) the presence of a rounded bottom on a bottom end located below the solid partition. The partition of Burns cannot constitute both a solid partition and a rounded bottom below the partition.

For these reasons, Burns does not anticipate claim 1.

Nor would Burns render claim 1 obvious.

There would have been no motivation for one skilled in the art to modify Burns by rounding the annular skirt 37 of the Burns container. If a user of the Burns collection container desired compatibility with diagnostic equipment, Burns provided its own solution – one or more extensions (90) placed into the annular skirt (37). (See Figs. 7 and 8, and Col. 5, lines 13-24.) Thus, one skilled in the art, reading Burns, would have had no apparent need to modify the Burns container for diagnostic compatibility.

In addition, Burns discloses that its annular skirt has two specific functions – allowing the assembly to be placed upright on a flat surface (Col. 3, lines 50-52), and being compatible with the container cap, such that the cap can be retained at the bottom of the Burns assembly during sample collection (Col. 5, lines 7-12). Modifying the Burns container in the manner necessary to reach Appellant's claimed invention goes against these explicit functions of the Burns container.

Moreover, such a modification of the Burns container would in fact destroy these two functionalities, since a rounded bottom would not appear to allow one to place the container on a flat surface, nor would the rounded bottom retain the cap during use. It is well-accepted that an obviousness rejection based on modifying or combining references in a manner that destroys the

references' intended function cannot stand. See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

For these reasons, Appellant submits that claim 1 is neither anticipated nor rendered obvious by Burns.

### CONCLUSION

For the reasons above, Appellants respectfully request of all rejections and allowance of claims 1 and 5-9.

If there are any additional fees related to this Appeal Brief, such fees should be charge to Deposit Account No. 02-1666.

Respectfully submitted,



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Date: July 3, 2003

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## APPENDIX

1. (four times amended) A one piece collection container assembly comprising:  
an elongate tubular housing having opposed first and second ends; and  
a solid partition positioned within said housing between said first and second ends;  
said housing defining a volume for specimen collection therein between said first end and  
said partition;  
said second end comprising a bottom end below said partition, said bottom end  
comprising a rounded bottom having an opening therein.
5. The assembly of Claim 1, wherein said partition is arcuate in shape to provide said  
volume for specimen collection with at least a partially rounded bottom portion.
6. The assembly of Claim 1, wherein said partition is conical in shape.
7. The assembly of Claim 1, wherein said housing is a thermoplastic polymer.
8. The assembly of Claim 7, wherein said thermoplastic polymer is polyethylene  
terephthalate, polypropylene, polyethylene napthalate, polyvinyl chloride or copolymers thereof.
9. The assembly of Claim 1, wherein said housing comprises an outer diameter, a length and  
an internal volume, wherein said outer diameter is about 13 to about 16 millimeters, said length  
is about 75 to about 100 millimeters and said internal volume is about 1 to about 3 milliliters.